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EXAMINER

FISCHER, ANDREW J

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 09/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/657,360

Applicant(s)
Motohisa Wantanabe

Examiner
Andrew J. Fischer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Aug 12, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above, claim(s) 5-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3 6) ☐ Other:

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DETAILED ACTION

Restriction

1. Applicant's election with traverse of Invention I (claims 1-8) in Paper No. 5 is acknowledged. The traversal is on the ground(s) that "search and examination of [the] entire application can be made without serious burden" This is not found persuasive because Applicant has not provided appropriate evidence to support his statement.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 9-16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable linking claim. Election was made with traverse in Paper No. 5.

Election of Species

3. Applicant's election with traverse of Species A (claims 1-4) in Paper No. 5 is acknowledged. The traversal is on the ground(s) that "search and examination of [the] entire application can be made without serious burden" Again, this is not found persuasive because Applicant has not provided appropriate evidence to support his statement.

The requirement is still deemed proper and is therefore made FINAL.

4. Claims 5-16 are independently withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic claim. Election was made with traverse in Paper No. 5.

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Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the Applicant regards as his invention.

6. Claims 2 and ³4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The claims are replete with errors. Some examples follow.

- a. In claim 2, the phrase “when on of the entries” is unclear.
- b. In claim 3, it is not known if “said operation including selecting said special menu key on said menu for designating a sales item” is the only operation which is searched or if there are additional operations to search. As currently claimed, it appears this is the only operation to be searched.
- c. In claim 4, the phrase “the same sales item code being assigned to the sale items assigned to said special menu key” is unclear. It is not known if Applicant intends the same sales item code to be assigned to multiple sale items since items is plural. Additionally, it is not known if the item or the code is then assigned to the special menu key or if the same code is assigned to both the special key (as in claim 4) and menu key (as in claim 3) since the “entry of sales items data being correlated to a code of said sales items.”

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Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-4, as understood by the Examiner, are rejected under 35 U.S.C. 102(b) as being anticipated by Rapoport et. al. (U.S. 5,262,938). Rapoport et. al. discloses a point of sale (“POS”) system with the following: a menu (figures 8-23) having a plurality of menu keys (choices listed under 80 “Category”) and at least one selection key (choices listed under 82 “Select Item”); a table (inherent in virtually all databases); each of the section keys being used to select one of a sales items assigned to each of the menu keys; a table containing entries of sales item data (description or name, price, and code all inherent); a display device (within 30); a first operation selecting a menu key (from category) is performed, entries of sales item data of all sales items assigned to the selected menu key are retrieved from the table and sales item data (name or description) are displayed on the display device (e.g. figure 8) in such a manner that entry of sales items data of the designated sales item (the particular item the user desires) is distinguished from entries of sales item data of correction alternative sales items (particular items the user does desire); the correction alternative sales items being sale items assigned to the selected menu key (e.g. they are all drinks under the drink category) and the alternative sales

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items are not the selected (or desired) sales item; wherein a second operation is performed (selecting one of the "Select Items" form 82) with the selected entry treated as an entry to be processed; means for searching (by selecting a particular category from 80, viewing the selected items in 82, and then selecting a different category from 80) the table for entries of correction alternative sales item data; display control means (the video controller inherent in any computer); sales items registering means (the enter button); a key table containing the code (virtually all databases have at least one keyed field to prevent redundancy) of sale items (e.g. coffee) and operations (e.g. add coffee to the customer's tab); a special menu key (the first menu choice in the list of choices, special because its first) and the user searches the keyed table for a sales items code operation (add coffee to the customers tab) and item code (coffee).

9. It is the Examiner's primary position that sales item codes corresponding to a sales item and an operation are inherent in Rapoport et. al. Clearly one of ordinary skill in the art would know that, for example, "coffee" as shown in figure 8 under "Selected Item" 82 is stored not as text but as a code. This is done because its easier to store and manipulate the codes of the items instead of the variable lengths of the descriptions.

Additionally, the user of the system must search through the hierarchical menu to find e.g. coffee within the "Drinks" menu. Similarly, searching as noted above by the Examiner is also searching by sales item code since the description represents the code and its the code which is actually tracked and stored. All other features in claim 1-4 are either disclosed or inherent in Rapoport et. al.

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Furthermore, to support this position on inherency, the Examiner notes that “[t]he law is clear that patent documents need not include subject matter that is known in the field of the invention and is in the prior art, for patents are written for persons experienced in the field of the invention. ... To hold otherwise would require every patent document to include a technical treatise for the unskilled reader.” *S3 Inc. v. nVIDIA Corp.*, 259 F.3d 1364, 1371, 59 USPQ2d 1745, 1749-50 (Fed. Cir. 2001) citing *Vivid Technologies, Inc. v. American Science and Engineering, Inc.*, 200 F.3d 795, 804, 53 USPQ2d 1289, 1295 (Fed. Cir. 1999) (“patents are written by and for skilled artisans”).

10. Functional recitations using the word “for” or “when” (e.g. “for designating a sales item on said menu . . .”) have been given little patentable weight because they fail to add any structural limitations and are thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. *In re Casey*, 152 USPQ 235 (CCPA 1967); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

11. The Examiner notes that, “A system is an apparatus.” *Ex parte Fressola* 27 USPQ2d 1608, 1611 (B.P.A.I. 1993)(citations omitted). And “[c]laims in apparatus form conventionally fall into the 35 U.S.C. § 101 statutory category of a ‘machine.’” *Ex parte Donner*, 53 USPQ2d 1699, 1701 (B.P.A.I. 1999)(unpublished), (Paper No. 34, page 5, issued as U.S. Patent 5,999,907). Applicant’s invention is therefore within the ‘machine’ category of §101.

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12. After careful review of the specification and prosecution history, the Examiner is unaware of any desire—either expressly or implicitly—by Applicant to be his own lexicographer and define a claim term to have a meaning other than its ordinary and accustom meaning. Therefore, the Examiner starts with the presumption that all claim limitations are given their ordinary and accustom meaning. See *Bell Atlantic Network Services Inc. v. Covad Communications Group Inc.*, 262 F.3d 1258, 1268, 59 USPQ2d 1865, 1870 (Fed. Cir. 2001) (“[T]here is a heavy presumption in favor of the ordinary meaning of claim language as understood by one of ordinary skill in the art.”); *CCS Fitness Inc. v. Brunswick Corp.*, 288 F.3d 1359, 62 USPQ2d 1658, 1662 (Fed. Cir. 2002) (There is a “heavy presumption that a claim term carries its ordinary and customary meaning.”). See also MPEP §2111.01 and *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).¹

However, if Applicant does desire any claim limitation to have a meaning other than its ordinary and accustom meaning, the Examiner respectfully requests Applicant in his next response to expressly indicate the claim limitation at issue² and to show where in the

¹ It is the Examiner’s position that “plain meaning” and “ordinary and accustom meaning” are synonymous. See e.g. *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342, 60 USPQ2d 1851, 1854 (Fed. Cir. 2001) (“[A]ll terms in a patent claim are to be given their plain, ordinary and accustomed meaning . . .”).

² “In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or

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specification or prosecution history the limitation is defined. Such definitions must be clearly stated in the specification or file history. *Bell Atlantic*, 262 F.3d at 1268, 59 USPQ2d at 1870, (“[I]n redefining the meaning of particular claim terms away from the ordinary meaning, the intrinsic evidence must ‘clearly set forth’ or ‘clearly redefine’ a claim term so as to put one reasonably skilled in the art on notice that the patentee intended to so redefine the claim term”).³ The Examiner cautions that no new matter is allowed.

Failure by Applicant in his next response to address this issue or to be non-response to this issue entirely will be considered a desire by Applicant to give all claim limitations their

otherwise affect a patent’s scope must, at the very least, point to a term or terms in the claim with which to draw in those statements.” *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

³ See also *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582, 39 USPQ2d 1573, 1576 (Fed. Cir. 1996), (“[A] patentee may choose to be his own lexicographer and use terms in a manner other than their ordinary meaning, *as long as* the special definition of the term is *clearly stated* in the patent specification or file history. [Emphasis added.]”); *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998) (“Such special meaning, however, must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention.”). See also MPEP §2111.02, subsection titled “Applicant May Be Own Lexicographer” and MPEP §2173.05(a) titled “New Terminology.”

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ordinary and accustom meaning. The claims are then interpreted with their “broadest reasonable interpretation” *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).⁴ Applicant is cautioned that even though claim interpretation begins with this presumption, any interpretation disclaimed during prosecution may still further limit that claim element. See *Pall Corp. v. PTI Technologies Inc.*, 259 F.3d 1383, 59 USPQ2d 1763, 1769 (Fed. Cir. 2001).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 2-4, as understood by the Examiner, are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Rapoport et. al. in view of Fuyama (U.S. 6,049,780).⁵ It is the

⁴ See also MPEP §2111; *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995); *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc).

⁵ See MPEP §2112 expressly authorizing alternative 102/103 rejections when the question of inherency is present in a §102 rejection.

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Examiner's primary position that Rapoport et. al. inherently discloses codes of sale items because of the rationale as discussed above.

However, if not inherent, Fuyama directly discloses price look up codes ("PLU Codes") and locating items by PLU codes in a PLU table (e.g. Figures 107 and 108). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Rapoport et. al. as taught by Fuyama to include sales item codes. Such a modification would have merely disclosed the common technique of using price look up codes to designate orders or other database entries and to search or located particular items.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure includes the following: Hashimoto (U.S. 6,441,808 B1); Gladwin et. al. (U.S. 6,209,034 B1); Van Kleek (U.S. 6,008,799); Hirano et. al. (U.S. 5,943,054); Camaisa et. al. (U.S. 5,845,263); Oliveros (U.S. 5,682,151); Iguchi (U.S. 5,589,676); Mueller et. al. (U.S. 5,353,219); Mueller et. al. (U.S. 5,235,509); Dorr (U.S. 4,530,067) and Moderi et. al. (U.S. 5,510,979).

16. All MPEP sections cited within are from the Manual of Patent Examining Procedure (MPEP) Eighth Edition, August 2001 unless expressly noted otherwise.

17. The art unit and technology center for this application has changed. The new art unit is 3627 in technology center 3600. So that papers may be properly matched, please indicated the new art unit on any paper submitted with this application.

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18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew J. Fischer whose telephone number is (703) 305-0292.

AJ Fischer 8/28/02
ANDREW J. FISCHER
PATENT EXAMINER

AJF
August 28, 2002